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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,048	06/21/2000	Michael C. Murray	MS1-563US	7795

22801 7590 10/29/2003		EXAMINER
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ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 10/29/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 August 2003</u> .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-69* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 June 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

1.   This action is in response to Amendment A, filed 6 August 2003.

2.   As per Applicant's request, the Specification has been amended. Claims 1-69 are

pending.

Drawings

3.   In view of the amendment to the Specification, the objection to the drawings is hereby

withdrawn.

Specification

4.   In view of the amendment to the Specification and the explanation regarding the table

and flow chart, the objections raised in the First Office Action are hereby withdrawn.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claims 40-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-

statutory subject matter, a data structure.

6.   Nonstatutory Subject Matter

Claims to computer-related inventions that are clearly nonstatutory fall into the same

general categories as nonstatutory claims in other arts, namely natural phenomena such as

magnetism, and abstract ideas or laws of nature which constitute "descriptive material."

Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere

manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58,

are not patentable. Descriptive material can be characterized as either "functional

descriptive material" or "nonfunctional descriptive material." In this context, "functional

descriptive material" consists of data structures and computer programs which impart

functionality when employed as a computer component. (The definition of "data

structure" is "a physical or logical relationship among data elements, designed to support

specific data manipulation functions." The New IEEE Standard Dictionary of Electrical

and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material"

includes but is not limited to music, literary works and a compilation or mere arrangement

of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive

material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional

descriptive material is recorded on some computer-readable medium it becomes

structurally and functionally interrelated to the medium and will be statutory in most cases

since use of technology permits the function of the descriptive material to be realized.

Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.

1994) (claim to data structure stored on a computer readable medium that increases

computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d

at 1759 (claim to computer having a specific data structure stored in memory held

statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d

at 1760 (claim to a data structure per se held nonstatutory). When nonfunctional

descriptive material is recorded on some computer-readable medium, it is not statutory

since no requisite functionality is present to satisfy the practical application requirement.

Merely claiming nonfunctional descriptive material stored in a computer-readable medium

does not make it statutory. Such a result would exalt form over substance. In re Sarkar,

588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("Each invention must be

evaluated as claimed; yet semantogenic considerations preclude a determination based

solely on words appearing in the claims. In the final analysis under 101, the claimed

invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele,

684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077,

200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting").

Thus, nonstatutory music is not a computer component and it does not become statutory

by merely recording it on a compact disk. Protection for this type of work is provided

under the copyright law.

Examiner agrees that claim 40 is a data structure (tangibly) embodied on a computer-

readable medium. However, Applicant has not recited the functional interrelationship between

the first, second, and third sub-structures to constitute a true data structure. There exists a need

to recite a functional interrelationship. It should be noted that the first, second, and third sub-

structures have "indicative of" features, which "can be" used for intended functions.

Claim Rejections - 35 USC § 112

7.   Examiner hereby withdraws the 35 USC 112 second paragraph rejections of claims 64 &

65.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9.   Claims 1-69 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent

6253366 to Mutschler, III.

Per claims 1 & 17:

-describing one or more software extensions using descriptions, the extensions being configured

for incorporation in a software platform executing on a client; (Col. 4, lines 21 –30 and 48-60,

"...combines the benefits of the Web-based XML standard for defining, validating and sharing

document formats on the Web...." and "...generate Document Type Definitions...for the

Extensible Markup Language...")

-delivering the descriptions of the one or more extensions to the client via the network, the

descriptions being configured for use in downloading the software extensions via the network.

(Col. 6, lines 13-16, "The term "import" as used herein shall mean the creation of an object

based on a description of an object transmitted from an external entity.")

Per claim 2: (Col. 2, line 22.)

Per claims 3, 30, and 56: (Figs. 3A, 3B, & 3C and col. 7, lines 20-25.)

Per claims 4, 57, and 65: (Figs. 3A, 3B, and 3C and col. 4, lines 21-28.)

Per claim 5: (Col. 2, line 22 and col. 4, lines 21-28.)

Per claims 6 and 20: (Col. 4, lines 31-39.)

Per claims 7, 8, 17, and 21: (Col. 4, lines 31-39 and col. 5, lines 16-20.)

Per claims 9, 13, 22, 23, 27, 35, 45, 49, 50, and 54: (Col. 4, lines 31-35.)

Per claims 10, 13, 24, 27, 36, 45, 50, and 54: (Col. 3, line 60 – col. 4, line 9.)

Per claims 11, 13, 25, 27, 37, 45, 50, and 54: (Col. 4, lines 1-10.)

Per claims 12, 13, 26, 27, 38, 50, and 54: (Col. 4, lines 11-18.)

Per claim 14: (Col. 4, lines 21-28 and 29-39.)

Per claim 15: (Col. 4, lines 48-56.)

Per claim 16: (Col. 4, lines 56-60.)

Per claims 18 & 28:

-describing one or more software extensions using one or more descriptive files, the extensions

being configured for incorporation in a software program executing on a client; (Col. 4, lines 21-

30 and 48-60 and col. 6, lines 13-16.)

-associating the one or more descriptive files with one or more associated extension files that are

useable to provide a program functionality; (Col. 4, lines 54-56.)

-storing the descriptive files and associated extension files in a network-accessible location;

(Fig. 2, DTD.)

-delivering the descriptive files and the associated extension files of the one or more extensions

to the client via a network; (Fig. 1.)

Per claim 19: (Col. 4, lines 48-56.)

Per claims 29 & 39:

-storing one or more extension definition files (EDFs) that describe a logical attachment to a

software application program; (Figs. 1 and 2, DTD.)

-storing one or more extension files that correspond to the one or more EDFs and extend the

software application program; (Col. 2, lines 37-43.)

-delivering, via a network, at least one EDF to a client; delivering, via a network, at least one

extension file that corresponds to the at least one EDF to a client. (Col. 4, lines 29-39.)

Per claim 31: (Col. 2, line 22.)

Per claim 32: (Col. 4, lines 65-66.)

Per claim 33: (Col. 4, lines 48-60.)

Per claims 34: (Col. 4, lines 51-54.)

Per claim 40:

-a first sub-structure indicative of a software extension that is to be incorporated in a software

application program; one or more second sub-structures associated with the first sub-structure

and indicative of feature types that can be added by the extension to the application program;

one or more third sub-structures associated with the one or more second sub-structures and

indicative of features of an associated feature type that can added by the extension. (Col. 4, lines

1-8 and 21-39.)

Per claims 41, 42 and 43: (Figs. 3A, 3B, and 3C and col. 7, line 20 – col. 8, line 19.)

Per claim 44: (Col. 7, lines 45-46.)

Per claims 46 and 47: (Col. 4, lines 35-39.)

Per claims 48 and 54:

-navigating to a network site that maintains at least one software application program;

downloading a software application program from the network site, the application program

comprising multiple different functionalities that can assist a user in accomplishing different

tasks, the software application program being configured to be extended with software

extensions that are deliverable via a network and are described by at least one network-

deliverable file. (Col. 4, lines 24-39 and col. 5, lines 18-19.)

Per claims 51 and 54: (Col. 4, lines 24-26.)

Per claim 52: (Col. 4, lines 29-35 and col. 6, lines 20-23.)

Per claim 53: (Col. 4, lines 16-20 and line 65 – col. 5, line 4.)

Per claims 55, 62, and 64:

-accessing a web site through which one or more software extensions can be obtained; (Col. 6,

lines 11-16.)

-receiving at least one file that describes at least one software extension using a hierarchical

language that describes the software extension's logical attachment to a software application

program; receiving one or more software extension files; installing the one or more software

extension files based, at least in part, on the description contained in said at least one file. (Col.

4, lines 21-39 and col. 6, lines 29-49.)

Per claim 58: (Col. 6, lines 33-35.)

Per claim 59: (Col. 6, lines 50-51.)

Per claims 60 and 61: (Col. 5, lines 21-23.)

Per claim 63:

-describing one or more software extensions using one or more extensible markup language

(XML) files, the extensions being configured for incorporation in a software program executing

on a client; associating the one or more XML files with one or more associated extension files

that are useable to provide a program functionality; storing the XML files and associated

extension files in a network-accessible location. (Col. 4, lines 21-39.)

Per claim 66:

-grouping multiple software extension descriptions in a catalog in a network-accessible location;

(Col. 5, lines 16-23.)

-accessing the network-accessible location; (Col. 6, lines 11-12.)

-using the catalog to update a software extension that is resident on a computing device. (Col. 6,

lines 22-36.)

Per claim 67: (Col. 5, lines 21-23.)

Per claim 68: (Col. 5, lines 18-19.)

Per claim 69: (Col. 4, lines 21-23.)

Response to Arguments

10.   Applicant's arguments filed 08/06/2003 have been fully considered but they are not

persuasive.

(A)   **Applicant has argued, in substance, the following:**

The Mutschler reference has nothing to do with "describing one or more software

extensions using descriptions, the extensions being configured for incorporation in a software

platform executing on a client" and "delivering the descriptions of the one or more extensions to

the client via the network...", but rather the reference simply describe aspects of Mutschler's

methods and systems for generating a compact Document Type Definition (DTD) for data

interchange among software tools (as stated on page 31 of Amendment A).

Examiner's Response:

In response to applicant's arguments, the recitation "A method for delivering software via

a network..." has not been given patentable weight because the recitation occurs in the preamble.

A preamble is generally not accorded any patentable weight where it merely recites the purpose

of a process or the intended use of a structure, and where the body of the claim does not depend

on the preamble for completeness but, instead, the process steps or structural limitations are able

to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*,

187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

See figure 1, which clearly shows a server, clients, and the transmission of DTD. "A

DTD is a set of rules governing the element types that are allowed within an XML document and

rules specifying the allowed content and attributes of each element type. The DTD also declares

all the external entities referenced within the document and the notations that can be used..."

(col. 4, lines 51-60). The Microsoft Computer Dictionary, Fifth Edition, defines DTD (page

179), "Acronym for document type definition. A separate document that contains formal

definitions of all of the data elements in a particular type of HTML, SGML or XML

document...By consulting the DTD for a document, a program called a parser can work with the

markup codes that the document contains." The DTD describes the software extensions.

Mutschler disclosed, "The present invention includes a DTD generator, which effect data

interchange among the tools (at the clients) and the repository (at the server) by defining the

contents..."(col. 5, lines 5-11).   Also note col. 5, line 3, "a TCP/IP connection..." is used to

"deliver via the network", the DTD to the clients.

(B)   **Applicant has argued, in substance, the following:**

Mutschler's systems and methods do not perform the "storing" and "delivering", as recited in

claim 29.

Examiners Response:

Examiner disagrees. Mutschler does store. See figure 2. The created DTD is used to place the

data (store) from the Application Model into the Tool at the client (deliver).

(C)   Applicant has argued, in substance, the following:

Mutschler fails to anticipate "accessing" a Web site, "receiving" at least one file that describes at

least one software extension and "installing" the one or more software extension files,

Examiners Response:

These acts are exactly what Mutschler's invention discloses. See figure 1. A web site (server) is

accessed, the clients receive / install or otherwise make use of the DTDs which describe the

software extensions.

Examiner maintains the rejections of claims 1-69.

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

A search update provided additional art:

US Patent 6,519,617 to Wanderski et al., (Creates dynamically generated XML dialect.

See fig. 2., Networked environment (col. 5-col. 6). Reference to URI at col. 8, line 25.)

US Patent 6,604,099 to Chung et al., (Optimized XML DTD schema of documents on the

WWW, using URLs.)

12.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing
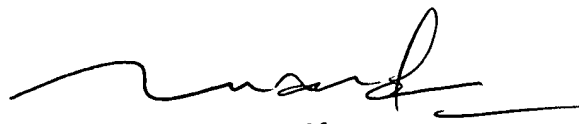
date of this final action.

13.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mary Steelman, whose telephone number is (703) 305-4564. The

examiner can normally be reached Monday through Thursday from 7:00 A.M. to 5:30 P.M. If

attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Gregory Morse can be reached on (703) 308-4789.

The fax phone numbers are (703) 872-9306 for regular communications and for After

Final communications. Any inquiry of a general nature or relating to the status of this

application or proceeding should be directed to the receptionist whose telephone number is (703)

305-3900.

Mary Steelman

10/16/2003

TUAN DAM
SUPERVISORY PATENT EXAMINER